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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,486	06/02/2005	Bruce McGarian	66455-255-7	5343
25769 7590 05/05/2009 DYKEMA GOSSETT PLLC FRANKLIN SQUARE, THIRD FLOOR WEST 1300 I STREET, NW WASHINGTON, DC 20005				
EXAMINER ANDREWS, DAVID L				
ART UNIT		PAPER NUMBER		
3672				
MAIL DATE		DELIVERY MODE		
05/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/530,486

**Applicant(s)**

MCGARIAN ET AL.

**Examiner**

DAVID ANDREWS

**Art Unit**

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-41 and 43-46 is/are allowed.
- 6) ☒ Claim(s) 42 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed 2/12/2009 has been entered.

#### ***Response to Arguments***

Applicant's arguments filed 2/12/2009, with respect to claims 42 and 47 have been fully considered but they are not persuasive.

Applicant argues that claim 42 now overcomes the prior art of rejection since the tool of Gano, including casing portion 110, cannot be "removably insertable in a wellbore." While the examiner agrees that that Gano would not be considered as such, this language is not within claim 42.

Applicant argues the rejection of claim 47 by stating that Ohmer does not have a bore portion [with a larger] diameter than a remainder of the bore located uphole and downhole of the bore portion. The examiner disagrees since Ohmer does disclose the claimed structure. In figure 3, bore portion (33), connects with remaining bore sections uphole (through which 60 extends, see fig 3) and downhole (20) which are a smaller diameter than the portion (33). This type of feature can also be seen in figures 16-19 of Ohmer, comparing the bore diameters shown in figures 17 and 19, where bore 168 with a diameter shown in figure 17 as 182 (comparable to portion 33 of figure 3) is shown as larger diameter than the bore 174 in figure 19 (comparable to the portion to which 60 extends in figure 3). The downhole bore (20) being smaller than portion 33 is clearly shown in figure 3.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Gano (US 6,053,254). Gano discloses a method of using a downhole deflector tool which includes a body incorporating a wall provided with an opening extending therethrough (110; opening is the lateral borehole); a hollow tubular deflector member (136) slidably mounted in the body (col. 4, lines 46-52) and having a deflecting surface for deflecting downhole equipment laterally within the body (figure 3); the deflector being slidable between an open position, in which the deflecting surface is located adjacent and facing towards said body opening so that downhole equipment laterally deflected by the surface is directed through the opening (figure 3); and a closed position in which the deflector member is oriented relative to the body opening so as to prevent downhole equipment from being laterally deflected through the opening (figure 2); and constraining means for restricting movement of the deflector member relative to the body (col. 4, lines 25-55); wherein the method comprises the steps of running the tool down a wellbore (inherent to its being downhole as in any figure); aligning said opening of the tool body with a lateral borehole extending from the wellbore (when lateral

borehole is drilled, the opening are aligned); and selectively moving said deflector member between said open and closed positions (fig 2/fig 3).

Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Ohmer (US 6,209,645). Ohmer discloses a downhole deflector member comprising: a cylinder having a window provided in a side thereof (12) and having a ramp (30) defined on an interior surface thereof for deflecting, in use, downhole equipment through said window; wherein a bore extends longitudinally through the deflector member (20) so as to allow, in use, the passage of downhole equipment through the deflector member without deflection by the ramp; and wherein a portion of the bore which extends uphole from a base of said ramp (uppermost portion above where 33 is pointing) has a larger diameter than a remainder of said bore (through which 60 extends or 20), said remainder of said bore being located both uphole and downhole of the portion of the bore.

***Allowable Subject Matter***

Claims 33-41 and 43-46 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID ANDREWS whose telephone number is (571)272-6558. The examiner can normally be reached on M-F, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571)272-6558. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David J. Bagnell/  
Supervisory Patent Examiner, Art Unit 3672

DLA  
4/28/09